



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/073,877	05/07/98	FORD	L LN.010

SUSANNE M HOPKINS, ESQ.  
LIFENET  
5809 WARD COURT  
VIRGINIA BEACH VA 23455

QM12/0707

EXAMINER

HIRSCH, P

ART UNIT	PAPER NUMBER
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3732

DATE MAILED:

*11*  
07/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/073,877**

Applicant(s)  
**Ford et al**

Examiner  
**Paul Hirsch**

Group Art Unit  
**3732**



☒ Responsive to communication(s) filed on May 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

The request filed on May 19, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/073877 is acceptable and a CPA has been established. An action on the CPA follows.

#### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The previous rejection of claims 1-26 in the prior Office action, i.e., the Final Rejection mailed November 19, 1999, Paper No. 7 is repeated and incorporated herein as follows:

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senter et al in view of Heggeness et al, Wagner et al, Cottle, Gross et al and McKay. While Senter et al teaches an implant of included protrusions it would be obvious in view of both the teachings of Senter et al and Heggeness et al of known allografts to form a prosthesis such as taught by Senter et al with the known and conventional shapes of spinal prosthesis. Heggeness et al teaches (col. 1, lines 43-57 for example) that allografts can be produced in various sizes and shapes. The inclusion of various shaped protrusions such as ridges, pyramids, points of known construction in bone prosthesis such as taught by Wagner et al, Cottle, McKay and Gross et al is considered a matter

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of obvious design choice to one of ordinary skill in the art as well as specific dimensioning. The method steps of claims 3-4 and 24 ( milling is a known method of article manufacture), would be obvious in view of the references applied.

### *Response to Arguments*

3. Applicant's arguments filed November 1, 1999 and May 19, 2000 have been fully considered but they are not persuasive. Applicant in their remarks have stated in their argument that the references just do not teach or make obvious their invention of a bone allograft of various shapes as recited by the claims. This is not found to be persuasive since as stated in the rejection both Senter et al (col. 2, lines 3-23) and Heggeness et al (col. 1, lines 44-57) teach as part of the known prior art allografts (which must have some shape) of an inherent shape with Heggeness et al teaching that the allografts may be produced in a variety of shapes and sizes. Accordingly, it follows that the known shapes of similar implants such as shown by Wagner et al, Cottle, McKay and Gross et al would be produced and obvious and/or known to a person of ordinary skill in the art. Accordingly, it is believed that that the apparatus and structure as broadly recited by the claims would be obvious from the teachings of the references applied.

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In response to applicant's argument that there is no suggestion to combine the references which is inclusive of the argument of teaching away, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated above both Senter et al and Heggeness et al teach prior art of known bone allograft with Senter et al showing an implant 50 inclusive of what may be termed protrusions 66,68 in the broadest sense and Heggeness et al stating that the allografts may be made in various shapes and sizes. Accordingly, the combination of these teachings with known prior art shapes is believed obvious to a person of ordinary skill in the art, and further in view of Heggeness et al the specific shape is one of obvious design choice.


### *Conclusion*

4. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and would have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Paul Hirsch whose telephone number is (703) 308-2697.



Paul J. Hirsch  
Primary Examiner

pjh

June 20, 2000